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08/932,784	09/18/1997	JAMES A. MCKAIN	A0521/7125	5693

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EXAMINER

NGUYEN, HUY THANH

ART UNIT PAPER NUMBER

2616

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/932,784

Applicant(s)

MCKAIN ET AL.

Examiner

HUY T. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,9 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/3/05, 5/31/05, 5/12/05, 5/10/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al (5,946,445) in view of Kojima et al (5,168,363)..

Regarding claims 1, 9 and 23, Peters discloses a digital motion picture recorder comprising:

a housing sized to be portable for use by an individual (Fig. 1);

processing means ( Fig. 1) in the housing for receiving the motion video signal from a video camera and a processing the received motion video signal;

a converting means for converting the motion video signal into a sequence of the still image (column 2);

storage means (5) for storing the sequence of still images on a computer readable and writable random access medium mounted in the housing (column 3);

means for specifying a sequence of still images ( video clip or different video clips) to be reproduced (column 3, lines 1-41) ; and

a motion camera (video camera) )for providing the moving picture to the recorder (Fig. 1).

Peters at figure 1 fails to specifically teach that the motion camera mounted in the housing having the recorder. However, it is noted that combining a camera with recorder for making a portable apparatus is well known in the art as taught by Kojima (Fig. 1 , column 1 lines 5-10) . Therefore, it would have been obvious to one of ordinary skill in the art to modify the digital recorder of Peters with Kojima by providing a motion camera in the same housing of the digital recorder for portability's purpose therefore providing more advantages to the user in handling the apparatus for capturing the pictures when needed.

3. Claims 1, 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bluth et al (3,617,626) in view of Washino (5,537,157) .

Regarding claims 1, 9 and 23, Bluth discloses a digital motion picture recorder (Fig. 1 columns 3-5) comprising:

a housing sized to be portable for use by an individual (Fig. 1);

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a motion camera (11) for providing motion video signals (column 12, lines 42-72);  
processing means (Fig. 1) in the housing for receiving the motion video signal from a video camera and for processing the received motion video signal;

a converting means (13) for converting the motion video signal into a sequence of the still images (frames) (column 12, lines 50-60\_);

storage means (digital recorder means) for storing the sequence of still images on a readable and writable random access medium mounted in the housing (column 12, lines 54-59)); and

means for selecting a sequence of the stored sequence still images to be reproduced (column 12, lines 59-65).

Bluth fails to specifically teach that the digital still images (frames) are stored on a computer readable and writable random access medium. However, it is noted that processing the motion picture from a camera for processing the motion picture into still frames and storing the digital still images on a digital computer readable and writable random access medium is well known in the art as taught by Washino. Washino teaches a processing means for processing the motion picture from a camera into a digital still images that can be recorded on digital computer readable and writable random access medium (8) (Figs. 2-3, column 6, lines 25-45, column 8, lines 28 to column 9, line 37). It would have been obvious to one of ordinary skill in the art to modify Bluth with Washino by using a processing means as taught by Washino for processing the motion picture from the camera into a sequence of still images that can be recorded and read on and from a computer random access medium thereby

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enhancing the function of the apparatus of Bluth to facilitate accessing and retrieving the stored digital motion picture when needed .

### ***Response to Arguments***

4. Applicant's arguments filed 03 May 2005 have been fully considered but they are not persuasive.

Rejection Under 35 U.S.C. §103 in view of Peters and Kojima

Applicant argues that "First, the Office Action does not set forth a prima facie case for combining of the teachings of Peters and Kojima. In particular, the Office Action lacks citations to any evidence in support of the proposed reasons for combining Peters and Kojima in the manner suggested. The assertion relied upon in the Office Action is nothing more than a generalized statement of advantage, without regard to either the desirability or the feasibility of modifying the prior art and without any supporting citations to any authority. That is, the Office Action does not establish in the record any evidence - either from the references cited, or other evidence or even Official Notice- from which one can conclude, from the mere existence of a camcorder (exemplified by Kojima), that one of ordinary skill in the art would have found it both desirable."

In response, the examiner disagrees . It is noted that the evidence of combining a recorder with a camera is well known in the art at the time the invention was made that that utilizing by applicant . The reason for combining a recorder with a camera

into a housing to provide more advantage and convenience to a user in capturing the video or image when needed is also well recognized in the art and is purpose of creating the camera/recorder. Peter teaches a portable device that can comprise a recorder having means for specifying a sequence to be played back and a camera. Kojima teaches a recorder can be combined with a camera in a same housing. The combination of Peter and Kojima will provide a camera and a recorder within a housing for recording the video signal in a digital format and specifying a sequence of segment to be play pack.

Applicant argues that "one of ordinary skill in the art would not have been motivated to combine the teachings of Kojima and Peters. As noted above, Peters in essence teaches a portable computer system that receives a video signal and stores video information in data files on a digital random access computer readable and rewriteable recording medium. Peters states that the computer system can be portable for use in on-site live recording and mentions receiving a signal from a camera, yet Peters does not teach or even suggest that a camera should be included as part of that portable system." In response, the examiner disagrees. Simply incorporating the camera and recorder/player of Peters into the same housing is obvious and can it handle by one of ordinary skill in the art with the teaching of Kojima.

Claims 1, 9 and 23 were rejected under 35 U.S.C. §103 in view of U.S. Patent 3,617,626 ("Bluth") and U.S. Patent 5,537,157 ("Washino I").

Applicant argues that This rejection is improper and should be withdrawn because neither Bluth nor Washino 1, nor their combined teachings, teaches or suggests the limitations of the independent claims regarding any function, within a portable housing, for enabling an individual to specify sequences of segments of stored video. In particular, the Office Action asserts, at page 4, line 9, that Bluth teaches a "housing sized to be portable for use by an individual," referring to Fig. 1 of Bluth. No such housing is shown in Fig. 1 of Bluth. Instead, Fig. 1 is referred to as a "system" throughout Bluth. There is nothing in Bluth that teaches or suggests that all of the components of this system, particularly editing, are found in a portable housing.

In response, the examiner disagrees. Bluth , at column 3, lines 12- 25, teaches an electronic system that includes a camera, recording/ play back means an editing means . The electronic system must have a body and housing to cover and contain the circuits of the camera , recording/play back means and editing means . Bluth further teaches the electronic system is a portable system since a recorded scene (sequence) can be played back immediately during shooting for monitoring (See Abstract) .

Applicant argues that "no citation to any evidence regarding the desirability or feasibility of such a combination as provided . .Regardless of the propriety of the proposed combination of Bluth and Washino I, neither Bluth nor Washino I teaches a housing sized to be portable by an -individual that includes both a motion video camera and a means that enables the individual to specify or define a sequence of segments of stored sequences of digital still images as claimed in claims 2, 9 and 23. Bluth fails to



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teach the claimed portable housing, and thus fails to teach a portable housing that includes a camera and functions for enabling an individual to specify sequences of segments of stored video. In Washino I, any housing that contains a camera does not contain functions for enabling an individual to specify sequences of segments of stored video. Because neither Bluth nor Washino teaches or suggest a "housing sized to be portable by an individual "that includes both a motion video camera and functions for enabling the individual to specify or define a sequence of segments of stored sequences of digital still images as claimed in claims 1, 9 and 23, the rejection of claims 1, 9 and 23 in view of Bluth and Washino I is traversed."

In response, the examiner disagrees . It is noted that Bluth teaches a system having a camera , recorder and means for specifying sequence for playing back . The camera , recorder and specifying means are incorporated in a housing of the electronic system (Fig. 1, column 3 lines 12-25) . The housing is sized to be portable since Bluth teaches that the system is an electronic system and a scene ( recorded sequence) can be played back immediately during shooting for monitoring by individual (See Abstract , column 1, lines 60-70) and Washino teaches a camera and a recorder also within a housing sized to be portable . The combination of Bluth and Washino will provide means for format the video signal from the camera of Bluth into a digital format that can be read by a computer . Changing the digital video signal of Bluth to readable computer format will enhancing the capacity of th system of Bluth and provide more advantage in accessing and retrieving the digital video signal.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1,9 and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/897506. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the recited feature in claims 1,9 and 23 of the present application and claim 1 of copending Application No. 10/897506 is that claim 1 of copending Application No. 10/897506 recites means for specifying a sequence of segment and that claims 1,9 and 23 of the present application recite editing means for specifying a sequence of segment. However, it is noted that one of ordinary skill in the art can recognize that the means for specifying of claims 1 of copending Application No. 10/897506 and editing means of claims 1,9 and 23 of the present application are similar since they perform the same function.

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Therefore, it would have been obvious to one of ordinary skill in the art to modify claim 1 of copending Application No. Application No. 10/897506 by changing means for specifying of claims 1 copending Application No. 10/897506 to editing means to produce claims 1,9 and 23 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N

  
HUYNH NGUYEN  
PRIMARY EXAMINER